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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,918	12/12/2001	Louis Guillou	9320.134USWO	3008
23552	7590	08/15/2007	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2131	
			MAIL DATE	DELIVERY MODE
			08/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)
	09/889,918	GUILLOU ET AL.
	Examiner	Art Unit
	Matthew T. Henning	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 6/7/2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-26 and 29-41 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 20-24 and 29-39 is/are allowed.
- 6) Claim(s) 25 and 40 is/are rejected.
- 7) Claim(s) 26 and 41 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 December 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. 8/13/2007.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

1 This action is in response to the communication filed on 6/7/2007.

2 **DETAILED ACTION**

3 **Remarks**

4 The examiner notes that claim 26, line 6 (on page 8 line 2 of the response) appears to be
5 unnecessary to the claim language and inconsistent with the other remaining claims.

6 ***Response to Arguments***

7 Applicant's arguments filed 6/7/2007 have been fully considered but they are not
8 persuasive.

9 The claim amendments made in an effort to overcome the rejection of claims 25 and 40
10 under 35 USC 101, have been given careful consideration, but remain directed towards non-
11 statutory subject matter. As these claims are directed towards methods for manipulating data in a
12 specific manner, the claims are directed towards an abstract idea and therefore are not tangible.

13 The newly added limitation of making the data available to an entity is not a physical
14 transformation outside of the computer, and does not provide any practical application to the
15 data, and as such the claims remain non-statutory. Again, the examiner recommends
16 incorporating the limitations of claims 26 and 41 into their respective parent claims, which will
17 resolve this issue, as well as remain consistent with the remainder of the independent claims.

18 Claims 20-26 and 29-41 have been examined. Claims 1-19 and 27-28 have been
19 cancelled.

20 All objections and rejections not set forth below have been withdrawn.

21 ***Claim Rejections - 35 USC § 101***

22 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25, and 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 25, and 40, a method which merely manipulates data is claimed.

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

See *MPEP* § 2106.2(b)

Although the claims do recite using the private values in an authentication or signature

34 method, the claim provides no details as to how the private values are used. Therefore, the
35 claims recite only data transformation inside a computer. As such, claims 25 and 40 fail to meet
36 the statutory requirements of 35 USC 101.

Allowable Subject Matter

Claims 20-24, and 29-39 are allowed.

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1 Claims 26 and 41 are objected to as being dependent upon a rejected base claim, but
2 would be allowable if rewritten in independent form including all of the limitations of the base
3 claim and any intervening claims.

4 The following is an examiner's statement of reasons for indicating allowable subject
5 matter: The reasons for indicating allowable subject matter are the same as those provided in the
6 office action dated 5/3/2005.

Conclusion

8 Claims 25 and 40 are rejected, claims 26 and 41 are objected, and claims 21-23, and 29-
9 39 are allowable over the prior art.

10 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
11 policy as set forth in 37 CFR 1.136(a).

12 A shortened statutory period for reply to this final action is set to expire THREE
13 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
14 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
15 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
16 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
17 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
18 however, will the statutory period for reply expire later than SIX MONTHS from the mailing
19 date of this final action.

20 Any inquiry concerning this communication or earlier communications from the
21 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.
22 The examiner can normally be reached on M-F 8-4.

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1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
9 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
10 like assistance from a USPTO Customer Service Representative or access to the automated
11 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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15 /Matthew Henning/
16 Assistant Examiner
17 Art Unit 2131
18 8/13/2007
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CHRISTOPHER REVAK
PRIMARY EXAMINER

